

### **REMARKS**

Please reconsider the application in view of the above amendments and the following remarks. Applicants thank the Examiner for the courtesies extended during the Examiner Interview and for carefully considering this application.

#### **Examiner Interview**

An Examiner Interview was conducted on June 29, 2009. Applicants have reviewed the Interview Summary mailed July 24, 2009 and agree with its contents.

#### **Disposition of the Claims**

Claims 1-18 were pending in this application. Claims 5, 9-12, and 15 are canceled by way of this reply without prejudice or disclaimer. Further, claims 19-27 are newly added by way of this reply. Accordingly, claims 1-4, 6-8, 13, 14, and 16-27 are currently pending in this application. Of the currently pending claims, claims 1, 13, and 25 are independent. The remaining claims depend, directly or indirectly, from claims 1, 13, and 25.

#### **Claim Amendments**

Claims 1, 13, 14, and 16-18 are amended by way of this reply to clarify aspects of the invention. No new subject matter is added by way of these amendments as support may be found, for example, on p. 1, ll. 27- p. 2, ll. 27 and p. 3, ll. 15- p. 5, ll. 22 and in Figures 2 and 3 of the Application as filed.

**Rejections under 35 U.S.C. § 112***Claims 1-18 – Physical Vicinity of the Merchant*

Claims 1-18 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. Specifically, the Examiner states that “while the customers are within the physical vicinity of the merchant” renders the claims indefinite. As discussed above, claims 5, 9-12, and 15 are canceled by way of this reply. Further, the aforementioned limitation is removed from the remaining claims. Accordingly, this rejection is now moot. Withdrawal of this rejection is respectfully requested.

*Claims 1-4 – subcombination/combination*

Claims 1-4 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. Specifically, the Examiner states that it is unclear whether the Applicants are claiming the subcombination, which includes human interface module, hosting means, and gateway means, or the combination, which also includes merchant and customers, of components recited in the claims. To the extent that this rejection applies to the amended claims, this rejection is respectfully traversed.

Claim 1 is amended by way of this reply to clarify that the claims are directed to a system that includes a merchant transaction terminal, which includes a human interface module and a hosting means. Further, the hosting means includes a scheduler, which is configured to process transactions between a single merchant and a plurality of customers. Although the scheduler recited

in claim 1 is configured to process transactions between a single merchant and a plurality of customers, claim 1 clearly does not claim the single merchant and the plurality of customers as a part of the system. In view of the above, claims 1-4, as amended, satisfy the requirements of 35 U.S.C. § 112. Withdrawal of this rejection is respectfully requested.

*Claims 5-18 – subcombination/combination*

Claims 5-18 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. Specifically, the Examiner states that it is unclear whether the Applicants are claiming the subcombination, which includes the transaction terminal, or the combination, which also includes merchant and customers, of components recited in the claims.

As discussed above, claims 5, 9-12, and 15 are canceled by way of this reply. Accordingly, this rejection is moot with regards to claims 5, 9-12, and 15. To the extent that this rejection applies to the remaining amended claims, this rejection is respectfully traversed.

Claims 6-8, 13, 14, and 16-18 are amended by way of this reply to remove the merchant and the plurality of customers. Therefore, the claims, as amended, satisfy the requirements of 35 U.S.C. § 112. Withdrawal of this rejection is respectfully requested.

**Rejection under 35 U.S.C. § 101**

Claims 1-18 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter for reciting human beings. As discussed above, claims 5, 9-12, and 15 are canceled by way of this reply. Accordingly, this rejection is moot with regards to claims 5, 9-12, and 15. To

the extent that this rejection applies to the amended claims, this rejection is respectfully traversed. Further, as discussed above, claims 6-8, 13, 14, and 16-18 are amended by way of this reply to remove the merchant and the plurality of customers. Accordingly, amended claims 6-8, 13, 14, and 16-18 satisfy the requirements of 35 U.S.C. § 101.

Finally, claims 1-4 are amended to clarify the type of transactions that the scheduler is configured to process. In other words, the single merchant and the plurality of customers are not being claimed, but rather are used to define the type of transactions in the claims. In view of the above, amended claims 1-4 satisfy the requirements of 35 U.S.C. § 101.

Withdrawal of this rejection is respectfully requested.

#### **Rejection under 35 U.S.C. § 103(a)**

MPEP § 2143 states that “[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.” Further, the Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1739, 75 U.S.L.W. 4289 (2007) noted that the analysis supporting a rejection under 35 U.S.C. § 103 should be made explicit. See MPEP § 2143. The analysis presented by the Examiner to support the rejection of the claims under 35 U.S.C. § 103 in the Action indicates that the Examiner found no differences between the cited prior art and the claims besides a lack of the actual combination of the elements in a single prior art reference, *i.e.*, that the Examiner is relying solely on the teachings of the prior art. See, e.g., MPEP § 2143(A). “To reject a claim based on this rationale, Office personnel must resolve the Graham factual inquiries. Then, Office personnel must articulate the following: (1)a finding that the prior art included each element claimed, although not necessarily in

a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference; (2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely performs the same function as it does separately; (3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and (4) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.” See MPEP § 2143(A). Applicants respectfully assert that all of the elements of the amended claims are not found in the cited prior art.

Claims 1, 2, 4, 5, 7, 9, 10, 12, and 13-17

Claims 1, 2, 4, 5, 7, 9, 10, 12, and 13-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Pub. No. 2004/0019564 (“Goldthwaite”) in view of International Publication No. WO 03/067530 (“Inotay”). As discussed above, claims 5, 9, 10, 12, and 15 are canceled by way of this reply. Accordingly, this rejection is moot with regards to claims 5, 9, 10, 12, and 15. To the extent that this rejection applies to the remaining amended claims, this rejection is respectfully traversed.

Claims 1, 2, 4, and 7

Claim 1 is directed to a system that includes a merchant transaction terminal. The merchant transaction terminal includes a human interface module and a hosting means. The hosting means connects the human interface module with a gateway means through a telecommunication

network. The hosting means includes a communication means and a scheduler means. The scheduler means controls the human interface module and the communication means to process transactions between a single merchant and multiple customers. *See, e.g.*, p. 3, ll. 15- p. 5, ll. 22 of the Specification.

Turning to the prior art, Goldthwaite is directed to a customer performing transactions over the Internet. Specifically, in Goldthwaite, the customer orders a product with the customer's personal computer. The customer indicates that the customer will pay with their phone when placing the order. An authentication server receives information about the order and obtains payment from the customer's phone. *See, e.g.*, Goldthwaite abstract and paragraph [0007].

Because the entire transaction is performed by the customer via the internet, Goldthwaite fails to disclose or render obvious a merchant transaction terminal for a single merchant and multiple customers. Moreover, because the processing of the transaction is controlled by the authentication server, Goldthwaite is silent with regards to anything that can be equated to a scheduler means, which controls both a human interface module and the communication means to process the multiple transactions as required by the amended claims.

As shown above, Goldthwaite fails to disclose or render obvious all of the limitations of claim 1, further, Inotay fails to disclose or render obvious that which Goldthwaite lacks. As an initial matter, to support the rejection of claim 1, the Examiner equates the scheduler means to a "payment utility" in Inotay and cites the Abstract and Page 2 and 3 of Inotay. Applicant respectfully note that neither the Abstract nor page 2 or 3 of Inotay disclose a "payment utility". Applicant respectfully requests that the Examiner provides the correct citation for "payment utility" if the Examiner persists in relying on the payment utility.

Further, Inotay fails to disclose or render obvious the scheduler means recited in the amended claims. Specifically, Inotay is directed to allowing a client to pay bills using the client's mobile phone. *See, e.g.,* Inotay, p. 2, ll. 9-12. In Inotay, the mobile phone is used by a single customer (*i.e.*, the client) because the subscriber identity module card on the mobile phone includes all of the customer's bank card information. The mobile phone in Inotay cannot include a scheduler means configured to process a transaction between a single merchant and multiple customers as required by the amended claims because it would require that mobile phone include bank card information for all of the customers, which is clearly a security vulnerability for each of the customers.

Moreover, Inotay is silent with regards to anything that can be equated to the scheduler means that is configured to control both the human interface module and the communication means to process such transactions as required by the amended claims.

In view of the above, Goldthwaite and Inotay, whether considered together or separately, fail to disclose or render obvious all of the limitations of claim 1. Accordingly, claim 1 is patentable over Goldthwaite and Inotay. Dependent claims 2, 4, and 7, which directly or indirectly depend from claim 1, are patentable over Goldthwaite and Inotay for at least the same reasons. Withdrawal of this rejection is respectfully requested.

*Claims 13, 14, 16, and 17*

Claim 13 is directed to a merchant transaction terminal. The merchant transaction terminal includes a human interface module and a subscriber identity module (SIM) card. The human interface module includes a keypad to receive an amount of the transaction and a card reader

to read a payment card. The SIM card includes a scheduler to process the transaction. Specifically, the processing of the transaction by the scheduler includes receiving payment card data and the amount from the human interface modules and communicating the information to a virtual terminal server. *See, e.g.*, p. 3, ll. 15- p. 5, ll. 22 of the Specification.

Turning to the prior art, as discussed above, Goldthwaite is directed to allowing a customer to pay for a product purchased via the internet using the customer's mobile phone. The only SIM card in Goldthwaite stores payment card information and an authentication application. *See, e.g.*, Goldthwaite, paragraph [0011]. Because the SIM card in Goldthwaite includes all of the payment information, the SIM card in Goldthwaite fails to disclose or render obvious the SIM card of the amended claims that includes a scheduler configured to process a transaction by receiving payment card information from a human interface module.

As shown above, Goldthwaite fails to disclose or render obvious all of the limitations of claim 13. Moreover, Inotay fails to disclose or render obvious that which Goldthwaite lacks. Specifically, the only SIM card in Inotay, like Goldthwaite, includes all of the payment information and is simply accessed to obtain the payment information. *See, e.g.*, Inotay, p. 5, ll. 9-12. Because the SIM card in Inotay includes all of the payment information, the SIM card in Inotay fails to disclose or render obvious the SIM card of the amended claims that includes a scheduler configured to process a transaction by receiving payment card information from a human interface module.

In view of the above, Goldthwaite and Inotay, whether considered together or separately, fail to disclose or render obvious all of the limitations of claim 13. Accordingly, claim 13 is patentable over Goldthwaite and Inotay. Dependent claims 14, 16, and 17, which directly or



indirectly depend from claim 13, are patentable over Goldthwaite and Inotay for at least the same reasons. Withdrawal of this rejection is respectfully requested.

*Alternative Rejection of Claims 1, 2, 4, 5, 7, 9, 10, 12, and 13-17*

Claims 1, 2, 4, 5, 7, 9, 10, 12, and 13-17 stand alternatively rejected under 35 U.S.C. § 103(a) as being unpatentable over Goldthwaite in view of Inotay in further view of the Examiner's Official Notice. As discussed above, claims 5, 9, 10, 12, and 15 are canceled by way of this reply. Accordingly, this rejection is moot with regards to claims 5, 9, 10, 12, and 15. To the extent that this rejection applies to the remaining amended claims, this rejection is respectfully traversed.

At the outset, Applicants disagree with the Examiner's Official Notice that "transaction terminals used for transactions between a merchant and a plurality of customers...are old and well known in the art" and, therefore, would be obvious "to program Goldthwaite's terminal into an old and well-known transaction terminal." See Action, pp. 9-10. Specifically, Applicants assert that (i) the above statement is not "common knowledge in the art [that is] capable of instant and unquestionable demonstration as being well-known" as required by MPEP § 2144.03 (A) and (ii) the Examiner has not provided "specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge" as required by *In re Soli*, 317 F.2d 941, 945-46, 137 USPQ 797, 800 (CCPA 1963); See MPEP § 2144.03 (B). More specifically, the Examiner is improperly making conclusory statements that the computer and the phone in Goldthwaite can be simply re-programmed to perform the same as the claimed invention. However, such reprogramming changes the function of the phone and the computer because the functionality of the phone and the computer is based on the phone and the computer having

confidential information of the customer and being specific to the customer. In other words, with the reprogramming, neither the phone nor the computer in Goldthwaite would perform the same function as it does separately as required under MPEP § 2143.

In view of the above, the Examiner has improperly taken Official Notice, as the Examiner has not provided the requisite information or rationale to the Applicants as to the basis of the Official Notice as specified in the MPEP. Accordingly, if the Examiner wishes to maintain the Official Notice, the Examiner is requested to provide documentary evidence in the next Office Action if the rejection is to be maintained. *See* 37 CFR 1.104(c)(2). *See also* *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697. *See also* MPEP § 2144.03 (C).

*Claims 1, 2, 4, and 7*

As discussed above, Goldthwaite and Inotay fail to disclose or render obvious a merchant transaction terminal for a single merchant and multiple customers; or a scheduler means, which controls both a human interface module and the communication means to process the multiple transactions as required by the amended claims. Further, the Examiner's Official Notice fails to disclose or render obvious that which Goldthwaite and Inotay lack.

Specifically, the Examiner only takes Official Notice that transaction terminals used for transactions between a merchant and multiple customers while the customers are within the physical vicinity of the merchant are old and well-known in the art. *See* Action p. 10. However, the Examiner has not taken Official Notice with regards to a scheduler means that controls both a human interface module and the communication means to process the multiple transactions as required by the amended claims.

In view of the above, Goldthwaite, Inotay, and the Examiner's Official Notice whether considered together or separately, fail to disclose or render obvious all of the limitations of claim 1. Accordingly, claim 1 is patentable over Goldthwaite, Inotay, and the Examiner's Official Notice. Dependent claims 2, 4, and 7, which directly or indirectly depend from claim 1, are patentable over Goldthwaite, Inotay, and the Examiner's Official Notice for at least the same reasons. Withdrawal of this rejection is respectfully requested.

*Claims 13, 14, 16, and 17*

As discussed above, Golthwaite and Inotay fails to disclose or render obvious a SIM card that includes a scheduler configured to process a transaction by receiving payment card information from a human interface module as required by the amended claims. Further, the Examiner has not taken Official Notice with regards to that which Goldthwaite and Inotay lack.

In view of the above, Goldthwaite, Inotay, and the Examiner's Official Notice, whether considered together or separately, fail to disclose or render obvious all of the limitations of claim 13. Accordingly, claim 13 is patentable over Goldthwaite, Inotay, and the Examiner's Official Notice. Dependent claims 14, 16, and 17, which directly or indirectly depend from claim 13, are patentable over Goldthwaite, Inotay, and the Examiner's Official Notice for at least the same reasons. Withdrawal of this rejection is respectfully requested.

*Claims 3, 6, 8, 11, and 18*

Claims 3, 6, 8, 11, and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Goldthwaite in view of Inotay, and in further view of U.S. Patent Pub. No.

2004/0012620 (“Buhler”). Claim 11 is canceled by way of this reply. Accordingly, this rejection is moot with respect to claim 11. To the extent that this rejection applies to the amended claims, this rejection is respectfully traversed.

*Claims 3, 6, and 8*

Claims 3, 6, and 8 depend, directly or indirectly, from amended independent claim 1. As discussed above, Goldthwaite and Inotay fail to disclose or render obvious a merchant transaction terminal for a single merchant and multiple customers; or a scheduler means, which controls both a human interface module and the communication means to process the multiple transactions as required by the amended claims. Further, Buhler fails to disclose or render obvious that which Goldthwaite and Inotay lack.

Specifically, Buhler is directed to allowing customers to create multimedia presentations for broadcast over television or the Internet. *See, e.g.*, Buhler, paragraph [0031]. Buhler is completely silent with regards to a scheduler means that controls both a human interface module and the communication means to process the multiple transactions as required by the amended claims.

In view of the above, Goldthwaite, Inotay, and Buhler whether considered together or separately, fail to disclose or render obvious all of the limitations of claim 1. Accordingly, claim 1 is patentable over Goldthwaite, Inotay, and Buhler. Dependent claims 3, 6, and 8, which directly or indirectly depend from claim 1, are patentable over Goldthwaite, Inotay, and Buhler for at least the same reasons. Withdrawal of this rejection is respectfully requested.

*Claim 18*

Claim 18 depends from amended independent claim 13. As discussed above, Goldthwaite and Inotay fails to disclose or render obvious a SIM card that includes a scheduler configured to process a transaction by receiving payment card information from a human interface module as required by the amended claims. Further, Buhler is completely silent with regards to a SIM card that includes a scheduler configured to process a transaction by receiving payment card information from a human interface module as required by the amended claims.

In view of the above, Goldthwaite, Inotay, and the Buhler, whether considered together or separately, fail to disclose or render obvious all of the limitations of claim 13. Accordingly, claim 13 is patentable over Goldthwaite, Inotay, and Buhler. Dependent claim 18, which directly or indirectly depends from claim 13, is patentable over Goldthwaite, Inotay, and Buhler for at least the same reasons. Withdrawal of this rejection is respectfully requested.

*Alternative Rejection of Claims 3, 6, 8, 11, and 18*

Claims 3, 6, 8, 11, and 18 stand alternatively rejected under 35 U.S.C. § 103(a) as being unpatentable over Goldthwaite in view of Inotay, in further view of Buhler, and in further view of the Examiner's Official Notice. Claim 11 is canceled by way of this reply. Accordingly, this rejection is moot with respect to claim 11. To the extent that this rejection applies to the amended claims, this rejection is respectfully traversed.

Claims 3, 6, and 8 depend from amended independent claim 1. Claim 18 depends from amended independent claim 13. As shown above, Goldthwaite, Inotay, Buhler, and the

Examiner's Official Notice, whether considered together or separately, fail to disclose or render obvious all of the limitations of claims 1 and 13. Accordingly, claims 1 and 13 are patentable over Goldthwaite, Inotay, Buhler, and the Examiner's Official Notice. Dependent claims 3, 6, 8, and 18, which directly or indirectly depend from claims 1 and 13 are patentable over Goldthwaite, Inotay, Buhler, and the Examiner's Official Notice for at least the same reasons. Withdrawal of this rejection is respectfully requested.

### **New Claims**

Claims 19-27 are newly added by way of this reply to clarify aspects of the invention. No new subject matter is added by way of new claims 19-27 as support may be found, for example, on p. 1, ll. 27- p. 2, ll. 27 and p. 3, ll. 15- p. 5, ll. 22 and in Figures 2 and 3 of the application as filed. Claims 19-24 depend from claims 1 and 13, and, therefore, are allowable over the cited prior art for at least the same reasons as claims 1 and 13.

With regards to new claims 25-27, similar to claim 13, new independent claim 25 requires a scheduler located in a SIM card for processing a transaction by receiving an amount and card data from a human interface module. As discussed above, the cited prior art fails to disclose or render obvious the aforementioned limitation. Therefore, new independent claim 25 is patentable over the cited prior art. New dependent claims 26 and 27 are patentable over the cited prior art for at least the same reasons. Favorable consideration of new claims 19-27 is respectfully requested.

## **Conclusion**

Applicants believe this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 09669/092001).

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